

REMARKS

The Office Action dated October 21, 2008, (hereinafter "Office Action") has been received and carefully considered. In this response, claims 1, 2, 5, 19, 20, and 22 have been amended. No new matter has been added. Entry of the amendments to claims 1, 2, 5, 19, 20, and 22 is respectfully requested. Reconsideration of the current rejections in the present application is also respectfully requested based on the following remarks.¹

I. THE NON-STATUTORY SUBJECT MATTER REJECTION OF CLAIMS 1-18

On page 3 of the Office Action, claims 1-18 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. This rejection is hereby respectfully traversed.

The Office Action asserts that claims 1-18 recite method steps and fail to positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. Applicants respectfully disagree. However in order to forward present application toward allowance, Applicants have amended claim 1 to recite apparatus that accomplishes the method steps.

¹ As Applicants' remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicants' silence as to assertions made by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., assertions regarding dependent claims, whether a reference constitutes prior art, whether references are legally combinable for obviousness purposes) is not a concession by Applicants that such assertions are accurate or such requirements have been met, and Applicants reserve the right to analyze and dispute such in the future.

In view of the foregoing, it is respectfully requested that the aforementioned non-statutory subject matter rejection of claims 1-18 be withdrawn.

II. THE ANTICIPATION REJECTION OF CLAIMS 1, 4-11, 15-19, 21-25, 29 AND 30

On page 4 of the Office Action, claims 1, 4-11, 15-19, 21-25, 29 and 30 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0229525 to Callahan *et al.* (“Callahan”). This rejection is hereby respectfully traversed.

Under 35 U.S.C. § 102, the Patent Office bears the burden of presenting at least a prima facie case of anticipation. In re King, 801 F.2d 1324, 1326 (Fed. Cir. 1986). Anticipation requires that a prior art reference disclose, either expressly or under the principles of inherency, each and every element of the claimed invention. Celeritas Tech., Ltd., v. Rockwell Int’l Corp., 150 F.3d 1354, 1361 (Fed. Cir. 1998). “In addition, the prior art reference must be enabling.” Akzo N.V. v. U.S. International Trade Commission, 808 F.2d 1471, 1479 (Fed. Cir. 1986), cert. denied, 482 U.S. 909 (1987). That is, the prior art reference must sufficiently describe the claimed invention so as to have placed the public in possession of it. In re Donohue, 766 F.2d 531, 533 (Fed. Cir. 1985). Such possession is effected only if one of ordinary skill in the art could have combined the disclosure in the prior art reference with his/her own knowledge to make the claimed invention. Id.

Regarding claim 1, the Office Action asserts that Callahan discloses the claimed invention. Applicants respectfully disagree. However, in order to forward the present application toward allowance, Applicants have amended claims 1 to more specifically define the claimed invention, and specifically those features that further differentiate the claimed invention from Callahan, as well as other cited references. In particular, Applicants respectfully submit

that Callahan fails to disclose, or even suggest, among other things, the following claim recitations of claim 1: "assessing, via server, an impact on the enterprise from a degradation of the services from the outside service provider, wherein assessing the impact on the enterprise comprises assessing a business impact on the enterprise and assessing a country impact on the enterprise," and "automatically determining, via the server, a criticality of the outside service provider in response to the assessment."

In contrast, Callahan does not disclose any feature or functionality that even remotely comprises assessment of an outside service provider ("OSP"), much less the specific claimed steps of: "assessing, via a server, an impact on the enterprise from a degradation of the services from the outside service provider, wherein assessing the impact on the enterprise comprises assessing a business impact on the enterprise and assessing a country impact on the enterprise," and "automatically determining, via the server, a criticality of the outside service provider in response to the assessment."

Rather, as evidenced by the excerpt referenced by the Office Action, Callahan merely discloses a risk rating system that is based on the values of residual risk, probability of occurrence and an impact value, but does not teach or suggest any feature or functionality wherein an impact rating on an enterprise based upon degradation of the services of an OSP, or a criticality rating of an OSP:

If there is a "no" response, comments are required in a comment box. The comment area is available for any other explanatory matter. If the assessor provides a "Not Applicable" (N/A) response, additional information is also required and the response activity to that question then stops. The risk rating for the question is based on three, intermediate numerical values, residual risk, probability of occurrence, also called "threat value," and an impact value. Based on the answer to the question and the additional information provided, the assessor is asked to rate the residual risk of the threat posed by the question using a numerical value. Typically, the numerical threat value is provided by the designers of the questions, for example, by the information security organization,

and is a rating of the probability of occurrence for the threat posed by the question. An impact value evaluation is requested of the assessor. For example, if a customer's name and address were inadvertently revealed (which would be in violation of GLBA) the impact is less critical than if account balances, account numbers, and transactions were revealed. The system then takes the average of the three ratings to come to a risk rating for a question. Based on this rating, the assessor then determines whether current controls in place are sufficient or not. If not, remediation information is required. Based on the risk ratings for individual questions, an overall risk rating for the assessment can be determined.

See ¶ 60, Callahan.

Applicants respectfully submit that the mere mentioning of an impact value in the manner of Callahan does not teach or suggest each and every element of the pending claims, particularly the steps of “assessing, via a server, an impact on the enterprise from a degradation of the services from the outside service provider, wherein assessing the impact on the enterprise comprises assessing a business impact on the enterprise and assessing a country impact on the enterprise,” and “automatically determining, via the server, a criticality of the outside service provider in response to the assessment,” that are expressly set forth in claim 1. As stated in MPEP § 2131, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987). Applicants respectfully submit that none of the other cited references make up for Callahan’s deficiencies in this regard.

Accordingly, is it respectfully submitted that claim 1 is allowable over Callahan and the other cited references.

Regarding claim 19, this claim recites subject matter related to claim 1. Thus, the arguments set forth above with respect to claim 1 are equally applicable to claim 19.

Accordingly, it is respectfully submitted that claim 1 is allowable over Callahan and the other cited references for the same reasons as set forth above with respect to claim 1.

Regarding claims 4-11, 15-18, 21-25, 29, and 30, these claims are dependent upon independent claim 1 or 19. Thus, since independent claims 1 and 19 should be allowable as discussed above, claims 4-11, 15-18, 21-25, 29, and 30 should also be allowable at least by virtue of their dependency on independent claim 1 or 19. Moreover, these claims recite additional features which are not disclosed, or even suggested, by the cited references taken either alone or in combination.

In view of the foregoing, it is respectfully requested that the aforementioned anticipation rejection of claims 1, 4-11, 15-19, 21-25, 29 and 30 be withdrawn.

III. THE OBVIOUSNESS REJECTION OF CLAIMS 2, 3, 12-14, 20 AND 26-28

On page 10 of the Office Action, claims 2, 3, 12-14, 20, and 26-28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Callahan, in view of U.S. Patent No. 6,856,973 to Bott (“Bott”) and further in view of U.S. Patent Application Publication No. 2002/0129221 to Borgia *et al.* (“Borgia”). This rejection is hereby respectfully traversed.

Under 35 U.S.C. § 103, the Patent Office bears the burden of establishing a prima facie case of obviousness. In re Fine, 837 F.2d 1071, 1074 (Fed. Cir. 1988). There are four separate factual inquiries to consider in making an obviousness determination: (1) the scope and content of the prior art; (2) the level of ordinary skill in the field of the invention; (3) the differences between the claimed invention and the prior art; and (4) the existence of any objective evidence, or “secondary considerations,” of non-obviousness. Graham v. John Deere Co., 383 U.S. 1, 17-18 (1966); see also KSR Int’l Co. v. Teleflex Inc., 127 S. Ct. 1727 (2007). An “expansive and flexible approach” should be applied when determining obviousness based on a combination of prior art references. KSR, 127 S. Ct. at 1739. However, a claimed invention combining multiple

known elements is not rendered obvious simply because each element was known independently in the prior art. Id. at 1741. Rather, there must still be some “reason that would have prompted” a person of ordinary skill in the art to combine the elements in the specific way that he or she did. Id.; In re Icon Health & Fitness, Inc., 496 F.3d 1374, 1380 (Fed. Cir. 2007). Also, modification of a prior art reference may be obvious only if there exists a reason that would have prompted a person of ordinary skill to make the change. KSR, 127 S. Ct. at 1740-41.

It is respectfully submitted that the aforementioned obviousness rejection of claims 2, 3, 12-14, 20, and 26-28 has become moot in view of the deficiencies of the primary reference (i.e., Callahan) as discussed above with respect to independent claims 1 and 19. That is, claims 2, 3, 12-14, 20, and 26-28 are dependent upon independent claim 1 or 19 and thus incorporate all of the limitations of independent claim 1 or 19. Also, the secondary references (i.e., Bott and Borgia) fail to disclose, or even suggest, the deficiencies of the primary reference as discussed above with respect to independent claims 1 and 19. Indeed, the Office Action does not even assert such. Thus, the combination of the secondary references with the primary reference also fails to disclose, or even suggest, the deficiencies of the primary reference as discussed above with respect to independent claims 1 and 19. Accordingly, claims 2, 3, 12-14, 20, and 26-28 should be allowable over the combination of the secondary references with the primary reference at least by virtue of their dependency on independent claim 1 or 19. Moreover, claims 2 and 3 recite additional features which are not disclosed, or even suggested, by the cited references taken either alone or in combination. The Office Action asserts that Bott discloses the claimed features of claims 2 and 3. Applicants respectfully disagree. Applicants respectfully submit that Callahan teaches away from Bott. In particular, Callahan discloses business units may provide a population of all third-party service providers and risk-rank them on the basis of the type of data

shared between the financial service company and the third-party service provider. *See*, paragraph [0028]. In contrast, Bott discloses a risk management system for international lending and assessing the risk associated with the lending on a per country basis. *See*, column 1, lines 6-8. Applicants respectfully submit that Callahan discloses risk-ranking established third-party service providers while Bott discloses risk assessment of international lending or investment in different countries. Therefore, Applicants respectfully submit that one having ordinary skill in the art at the time of the invention would not have combined the lending risk assessment of a country of Bott with risk-ranking of third-party service providers of Callahan.

In view of the foregoing, it is respectfully requested that the aforementioned obviousness rejection of claims 2, 3, 12-14, 20 and 26-28 be withdrawn.

IV. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,

Hunton & Williams LLP

By:



Ozzie A. Farres
Registration No. 43,606

Hunton & Williams LLP
1900 K Street, N.W.
Washington, D.C. 20006-1109
Telephone: (202) 955-1500
Facsimile: (202) 778-2201

Date: January 15, 2009